

REMARKS/ARGUMENT

Description of Amendments

Claim 14 is currently amended. Claim 18 is new. Claims 1, 2, 4-16, and 18 are pending after entry of this Amendment.

No new matter is introduced. Support for amended claim 14 and new claim 18 is found throughout the originally filed specification. For claim 14, support for applying pressure contemporaneously with applying the coating substance is found, for example, at Pub. 2004/0191405 para. 27. Support for new claim 18 is also found, for example, at para. 27.

Reconsideration and removal of the rejections are respectfully requested.

Allowable Subject Matter

Applicant appreciates the Examiner's indication that claims 8-10 would be allowable if rewritten in independent form, including all the limitations of the base claim and any intervening claims. However, for the reasons set forth below, Applicant respectfully submits that claims 8-10 are patentably allowable over the cited references for the same reasons as claim 1.

Rejection under 35 U.S.C. §103

Claims 1, 2, 4-7, and 11-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 6,214,115 ("Taylor") in view of US 6,153,252 ("Hossainy"). Applicant respectfully traverses.

Claim 1

Taylor and Hossainy, individually and when combined, fail to teach, suggest, or otherwise render obvious the claimed elements of:

applying a vacuumed pressure to the hollow tubular body for extracting some of the coating composition that is applied to the stent, wherein the pressure is applied at least during application of the coating composition to the stent

The Office states that Taylor "fails to teach applying the vacuum pressure during coating as well as rotating the stent while applying the pressure." The Office also states that it would have been obvious "to modify the process of Taylor et al. to include the steps of

applying the pressure while coating as well as rotating as taught by Hossainy et al. in order to insure any excess coating is removed and to form a defect free coating.”

Contrary to the Office’s assertion, Hossainy provides no teaching or suggestion to modify Taylor so that vacuum pressure is applied “during the application of the coating composition,” as recited in claim 1. In Taylor, vacuum is used to generate an air flow that removes coating composition from the stent’s apertures (Taylor col. 3, lines 2-4). In Hossainy, rotation of the stent is used to clear coating composition from the stent’s passages or slots (Hossainy col. 3, lines 39-48). In both Taylor and Hossainy, the application of coating composition corresponds to when the stent is submerged in a bath of the coating composition. Also, in both Taylor and Hossainy, the steps for removing any excess coating composition are performed after the stent is raised out from the bath of coating composition (Taylor col. 2, lines 63-66; Hossainy col. 3, lines 35-39), i.e., after the application of the coating composition. Therefore, the combination of Taylor and Hossainy does not teach or suggest “applying a vacuum pressure … during the application of the coating composition,” as recited in claim 1.

The mere assertion that that Taylor can be modified is insufficient to support an obviousness rejection. See MPEP §2143.01. “[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” KSR v. Teleflex, 127 S.Ct. 1727, 1740 (2007). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). “If when combined, the references ‘would produce a seemingly inoperative device,’ then they teach away from their combination.” Tec Air v. Denso Manufacturing Michigan, 192 F.3d 1353, 1360 (Fed. Cir. 1999).

Applicant submits that the cited references teach away from the Office’s proposed modification of Taylor. In Taylor, vacuum is applied to a stent support member after the stent support member and stent have been raised out from the reservoir of coating solution (col. 2, lines 49-67). The vacuum is intended to produce an air flow that ensures that liquid is not retained in apertures of the stent (col. 3, lines 2-4). Modifying Taylor so that the

vacuum is applied while the coating is applied to the stent, i.e., while the stent and stent support member are submerged in the coating solution, would not remove any excess coating or prevent the coating from blocking slots or apertures in the stent. When the stent is submerged in the coating solution, the same amount of coating solution would be on the stent with or without the vacuum. Application of the vacuum would only cause additional coating to be suctioned onto the stent as the coating is drawn into the stent support member. Therefore, a person of ordinary skill in the art would be discouraged from applying a vacuum during the application of the coating composition since doing so would be unproductive.

In addition to being unproductive, the Office's proposed modification appears to be counterproductive. "If when combined, the references 'would produce a seemingly inoperative device,' then they teach away from their combination." Tec Air, 192 F.3d at 1360. Also, a negative effect arising from proposed modification indicates a lack of motivation or suggestion to make the modification. See MPEP §2143.01, V, citing *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). In Taylor, applying the vacuum during the application of the coating composition, i.e., during submersion of the stent and stent support member in the coating solution, may clog the support member. When raised out from the coating solution, the clogged support member would have a reduced ability to generate air flow to remove excess coating. Therefore, a person of ordinary skill in the art would further be discouraged from applying a vacuum during the application of the coating composition since doing so would seemingly render Taylor's method inoperative or unsatisfactory for its intended purpose.

For the reasons stated above, Applicant respectfully submits that claim 1 is patentably allowable over Taylor in view of Hossainy.

Claim 11

Taylor and Hossainy, individually and when combined, fail to teach, suggest, or otherwise render obvious the claimed elements of:

performing the following acts contemporaneously:
applying a coating substance to the stent,
rotating the stent about the longitudinal axis of the stent, and
applying a pressure into the hollow body to modify the coating substance that is being applied to the stent.

Specifically, the claimed element of “contemporaneously ... applying a coating substance ..., and applying pressure” is not met by nor rendered obvious by the cited references, alone or when combined, for the reasons given above for claim 1.

Also, Taylor fails to meet claim 11 even if modified as proposed by the Office. In Taylor, applying a coating substance to the stent corresponds to submerging the stent and stent support member in a reservoir or bath of coating substance. Contemporaneously applying a pressure to the stent support member and applying the coating substance means that the pressure is applied while the stent and stent support member are submerged in the coating substance. Applying pressure would simply draw the coating substance contained in the reservoir toward the stent and into the stent support member. As the coating substance is drawn into the support member, more coating substance is drawn toward the stent. Thus, applying pressure while the stent and stent support member are submerged in the coating substance does not “modify the coating substance that is being applied to the stent,” as claimed.

Accordingly, Applicant respectfully submits that claim 11 is patentably allowable over Taylor in view of Hossainy.

Claim 14

Claim 14 has been amended to recite that “the application of the pressure is conducted contemporaneously with applying the coating substance.” The combination of Taylor and Hossainy does not teach or suggest this element of claim 14 for the same reasons given for claim 1. Also, as previously explained for claim 1, modifying Taylor as proposed by the Office -- so that pressure is applied during the application of a coating substance (i.e., during submersion of the stent and support member in a coating substance) -- provides no predictable results and would render Taylor’s process unsatisfactory for its intended purpose. In addition, Taylor fails to meet claim 14 even if modified as proposed by the Office since applying pressure during the application of the coating substance does not “modify the coating substance applied to the stent” as claimed. Accordingly, Applicant submits that claim 14 is patentably allowable over Taylor in view of Hossainy.

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Claims 2, 4-7, 12, 13, 15 and 16

Claims 2, 4-7, 12, 13, 15 and 16 depend from base claims 1, 11 or 14 and are patentably allowable over Taylor in view of Hossainy for at least the same reasons given above for their respective base claims.

Conclusion

In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested.

Respectfully submitted,

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